The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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**Ex parte** DALE F. MCINTYRE, HOWARD K. DWORSKY
and BRIAN H. MARKS

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Appeal No. 2004-0254
Application 09/451,315

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ON BRIEF

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Before JERRY SMITH, FLEMING, and RUGGIERO, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 through 33, all the claims pending in the instant application. Claims 34 through 43 have been canceled.

**Invention**

The invention relates to a computer system which utilizes personal images and games for advertising goods and/or services. See page 1 of Appellants' specification. Generally, games played

on computers are well known. With the wide spread popularity of computer games, companies have utilized these games on the Internet to advertise there products. See page 1 of Appellants' specification. Some of these games include the use of pictures supplied by the site such as an imaged-based tic-tac-toe game where a player is initially shown the position of the cartoon images and later asked to identify their locations. A win is rewarded with coupons which can be redeemed for prizes. See page 2 of Appellants' specification. The problem with such games for the advertiser is the images employed in the game don't hold a high degree of relevancy with any individual user and therefore lessen their interest in participating. The Appellants' invention increase the relevancy and value of the promotional space by utilizing personalized images into the playing structure of the game. See page 2 of Appellants' specification. Figure 4 illustrates one example of Appellants' invention. In particular, an image matching game is provided which comprises a matrix of images formed by a dimensional NxM. This matrix has 3 image display layers 52, 54, 56. Layer 52 comprises a plurality of cover image tiles 60, 62, 64 and 66 used for identifying sections of the matrix. The middle layer comprises consumer image tiles 68, 70, 72 and 74 used in playing the game. The bottom layer 56

comprises background image tiles 76, 78, 80 and 82. The consumer image tiles 68, 70, 72 and 74 are supplied by the consumer. In the embodiment illustrated, these images are obtained from a photofinishing order supplied by the consumer for processing. A roll of exposed undeveloped photographic film is sent to a photofinishing lab for processing. The developed images are digitized. The digitized images are then returned to the consumer on a CD. See page 7 of Appellants specification.

Figure 5 illustrates the games set procedure which show how the photos supplied by the consumer may be incorporated into the images used in the game. See pages 8 and 9 of Appellants' specification.

Appellants' claim 1 is representative of Appellants' invention and is reproduced as follows:

1. A computer software product comprising a computer readable storage medium having a computer program which when loaded into a personal computer causes the personal computer to perform the following steps:

a. locating and selecting at least one digital image supplied by a user and provided in said storage medium;

b. incorporating said image in a game; and

c. automatically displaying a prestored message to said user upon playing or completion of said game.

## References

The references relied on by the Examiner are as follows:

| | | |
|---|---|---|
| Forrest et al. (Forrest) | 5,679,075 | Oct. 21, 1997 |
| Small | 5,791,991 | Aug. 11, 1998 |
| Walker et al. (Walker) | 6,203,427 | Mar. 20, 2001 |
| | (filing date | Jul. 3, 1997) |
| Barnett et al. (Barnett) | 6,336,099 | Jan. 1, 2002 |
| | (filing date | Apr. 24, 1998 |

## Rejections at Issue

Claims 1, 7, 8, 12 and 14 through 16 stand rejected under 35 U.S.C. § 102 as being anticipated by Small. Claims 2, 10, 11, 13, 14, 15, 17, 22, 23 and 25 through 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Small. Claims 3 through 6 and 18 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Small in view of Walker. Claims 9 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Small in view of Barnett. Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Small in view of Forrest.

## OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and arguments of Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1, 7, 8, 12, 14 through 16 under

35 U.S.C. § 102 and we reverse the Examiner's rejection of claims 2 through 6, 9 through 11, 13 through 15 and 17 through 33 under 35 U.S.C. § 103.

We will first address the rejection of claims 1, 7, 8, 12 and 14 through 16 under 35 U.S.C. § 102.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King,** 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellants argue that Small fails to teach locating and selecting at least one digital image supplied by a user as recited in independent claim 1. Appellants argue that Small teaches that the images are provided by the advertiser and not the user. Appellants argue that Small fails to teach or suggest utilization of the image supplied by the user. See page 3 of Appellants' brief.

The Examiner argues that Small teaches in column 2, lines 59, through column 3, line 21, that the images are located and selected so that the game could be played by the consumer client, on the consumer client PC. The Examiner argues that the images

are taken to be supplied to the PC by the user when the user selects the appropriate game. See pages 4 and 8 of the Examiner's answer.

We find that Small teaches in column 6, line 35 through column 8, line 28, the Consumer Product Promotion Method. Small teaches that a consumer using a personal computer connects the personal computer to the Internet and select the web site address of the database 1 via CPU2. See Small, column 6, lines 35 through 45. The consumer then is instructed to select eight product categories for which the consumer would like to receive a discount. As each product category is selected the category number will be displayed under the bingo game card on the consumer's screen. Once the consumer has selected all eight categories, if the numbers of the selected categories match any product category numbers stored in the spaces in the bingo card, those spaces will be revealed. If the consumer has five matches, the consumer wins the game. See Small, column 6, line 50 through column 7, line 14. As shown in figure 4, at block 82, the CPU2 randomly generates the category numbers associated with the bingo spaces 44 and then compares the selected category numbers 48 against the bingo spaces 44 and removes the covered dollar sign 46 from any of the bingo spaces 44 which the match the product

category numbers 48. See Small, column 7, lines 14 through 21. Upon the entire reading of Small, we find that the Small reference teaches that the images are stored and provided by the advertiser. Therefore, we fail to find that the digital images are supplied by a user as required by Appellants' claims. Therefore, we will not sustain the Examiner's rejection of claims 1, 7, 8,. 12 and 14 through 16 under 35 U.S.C. § 102.

For the rejection of claims 2 through 6, 9 through 11, 13 through 15 and 17 through 33 under 35 U.S.C. § 103, we note that the Examiner has relied on Small for the teaching of locating and selecting at least one digital image supplied by the user as recited in the claims. Therefore, we will not sustain the rejection of these claims under 35 U.S.C. § 103 for the same reasons as above.

In view of foregoing, we have not sustained the Examiner's rejection of claim 1, 7, 8, 12 and 14 through 16 under 35 U.S.C. § 102 and we have not sustained the Examiner's rejection of claims 2 through 6, 9 through 11, 13 through 15 and 17 through 33 under 35 U.S.C. § 103.

**REVERSED**

JERRY SMITH )
Administrative Patent Judge )
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)
MICHAEL R. FLEMING ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS AND
)
JOSEPH F. RUGGIERO ) INTERFERENCES
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